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SUPPLEMENTAL APPEAL BRIEF UNDER 37 CFR § 41.37
Attorney Docket No. 042846-0313060
Application Serial No. 09/345,448



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE PATENT APPLICATION OF: Douglas W. CONMY, *et al.*
SERIAL NO.: 09/345,448
FILING DATE: July 1, 1999
ATTORNEY DOCKET NO.: 042846-0313060
CONFIRMATION NO.: 1268
ART UNIT: 2172
EXAMINER Anh Ly
FOR: SYSTEM AND METHOD FOR ENABLING A USER TO SUBSCRIBE TO UPDATES FROM INFORMATION SOURCES

SUPPLEMENTAL APPEAL BRIEF UNDER 37 CFR § 41.37

Mail Stop Appeal Brief - Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

Dear Sir:

In response to the Notice of Non-Compliant Appeal Brief mailed February 27, 2006, Applicants respectfully submit this Supplemental Appeal Brief.

No additional fees are believed to be due. However, the Director is authorized to charge any additional fees that may be due, or credit any overpayment of same to Deposit Account No. 033975 (Ref. No. 042846-0313060).

REQUIREMENTS OF 37 C.F.R. §41.37

I. 37 C.F.R. § 41.37(c)(1)(i) – REAL PARTY IN INTEREST

The real party in interest is International Business Machines Corporation.

II. 37 C.F.R. § 41.37(c)(1)(ii) – RELATED APPEALS AND INTERFERENCES

Appellants are aware of no related appeals or interferences.

III. 37 C.F.R. § 41.37(c)(1)(iii) – STATUS OF CLAIMS

Pending: Claims 1-4, 6-9, 11-19, 21-35, and 37 are pending.

Cancelled: Claims 5, 10, 20, and 36 are cancelled.

Rejected: Claims 1-4, 6-9, 11-19, 21-35, and 37 stand rejected.

Allowed: No claims have been allowed.

On Appeal: The rejections of claims 1-4, 6-9, 11-19, 21-35, and 37 are appealed.

IV. 37 C.F.R. § 41.37(c)(1)(iv) – STATUS OF AMENDMENTS

No amendments to the claims, specification, or drawing have been proposed subsequent to the final Office Action mailed December 18, 2003.

V. 37 C.F.R. § 41.37(c)(1)(v) – SUMMARY OF CLAIMED SUBJECT MATTER

Some embodiments of the invention may include subscription requesting means. In an exemplary embodiment, the subscription requesting means may include a request object, which may be implemented as a software modules, that enables a request of a

subscription. *See id.* at page 6, lines 15-21. For example, FIG. 1 illustrates an exemplary embodiment of a request object (subscription view 100) that may enable the user to request a subscription. The subscription requesting means may include a selection formula (selection formula field 114) that is programmed by the user. *See id.* at page 4, lines 28-30. The selection formula may include lines of program code that includes search criteria. *See id.*

According to various embodiments of the invention, the system may include subscription parameter receiving means. In an exemplary embodiment, the subscription parameter receiving means may include an update system. The update system may perform a receive criteria step by receiving criteria input by a user. *See id.* at page 7, lines 5-13.

In some embodiments of the invention, the system may include search performing means. In an exemplary embodiment, the search performing means may include an update system. The update system may retrieve, scan, and filter information desired by a user. *See id.* at page 6, lines 14-24. In some embodiments, the search performing means may search appropriate object stores (e.g. databases) on a random basis, which, in some cases, may be determined by a user. *See id.* at page 6, lines 25-32.

According to various embodiments of the invention, the system may include subscription retrieving means. In an exemplary embodiment, the subscription retrieving means may include an update system. The update system may retrieve objects from one or more object stores that match a search criteria. *See id.* at page 8, lines 9-20

In some embodiments of the invention, the system may include subscription notification means. In an exemplary embodiment, the subscription notification means may

include an update system. The update system may notify a user of objects that match a search criteria. *See id.* at page 7, lines 4 and 5.

According to some embodiments of the invention, the system may include option input means. In an exemplary embodiment, the option input means may include radio buttons, pull-down menus, and/or other selectable mechanisms that may receive an option relating to the subscription from the user. *See id.* at page 7, lines 16 and 17; and page 8, lines 5 and 6.

In some embodiments of the invention, the system may include subscription presenting means. In an exemplary embodiment, the subscription presenting means may include an update system. The update system may present a subscription to a user at a present objects step. *See id.* at page 6, lines 10-13.

According to various embodiments of the invention, the system may include syntax checking means. In an exemplary embodiment, the syntax checking means may include a “Check Syntax” function. *See id.* at page 4, lines 32 and 33. The “Check Syntax” function may be displayed as a selectable button. *See id.*

In some embodiments of the invention, the system may include subscription disabling means. The subscription disabling means may include a “Temporarily disable this subscription” option. *See id.* at page 5, lines 11-14.

VI. 37 C.F.R. § 41.37(c)(1)(vi) – GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL (35 U.S.C. § 103).

Claims 1, 6, 11, 13, 16, 33-35, and 37 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,374, 252 to Althoff *et al.* (“Althoff”) in view of U.S. Patent No. 6,119,101 to Peckover (“Peckover”).

Claims 2, 3, 7, 8, 14, 15, 17, and 18 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Althoff in view of Peckover, and further in view of U.S. Patent No. 6,141,653 to Conklin *et al.* (“Conklin”).

Claims 4, 9, 12, 19, and 21-32 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Althoff in view of Peckover, and further in view of U.S. Patent No. 6,020,980 to Freeman (“Freeman”).

VII. 37 C.F.R. § 41.37(c)(1)(vii) – ARGUMENT

A. CLAIMS 1, 6, 11, 13 AND 16

The rejection of claims 1, 6, 11, 13 and 16 under 35 U.S.C §103(a) as allegedly being unpatentable over Althoff in view of Peckover is improper at least for (1) failing to teach or suggest all of the features of the claimed invention, and/or (2) failing to provide a proper motivation for combining the references.

1. *Althoff and Peckover do not teach or suggest all of the features of the claimed invention.*

Independent claim 1 recites, *inter alia*, the subscription requesting means including a selection formula, wherein the selection formula is programmed by the user, the selection formula including search criteria corresponding to the subscription. Independent claims 6, 11, and 16 include similar subject matter, among other things. Dependent claim 13

depends from, and add features to independent claim 11, and therefore includes this subject matter. Althoff and Peckover, alone and in combination fail to teach this feature.

In the Office Action mailed April 18, 2005 (“the Office Action”), the Examiner asserts that a user interface including a GUI (shown in FIG. 2 as a box simply labeled “user interface subsystem,” element 210) reads on “subscription requesting means.” See the Office Action at page 3, lines 9-16. An exemplary embodiment of the selection formula is described in the Specification of the instant application, and is illustrated in Figure 1 (element 114), as enabling lines of program code to be input by a user. See the Specification at page 8, lines 8-10. However, Althoff expressly teaches that the user interface merely receives commands and descriptions from a user regarding querying or searching a database. See Althoff at col. 9, lines 44-47. In response thereto, Althoff discloses, the overall system, not the user, builds and edits a query model, which may then be translated by the system into SQL program code for querying the database. See *id.* at col. 9, lines 47-55.

Additionally, the Examiner asserts that the commands and/or descriptions of Althoff must subsequently be built into a query that can be translated into SQL program code teaches or suggests a selection formula that is programmed by a user. However, the Examiner’s assertion is inconsistent with the plain meaning of the word “program.” The Examiner must give the words in the claims their plain meaning. *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1372, 69 USPQ 2d 1857 (Fed. Cir. 2004). THE AMERICAN HERITAGE® DICTIONARY OF THE ENGLISH LANGUAGE, FOURTH EDITION, defines the word program as, “[t]o provide (a machine) with a set of coded working instructions.” This definition supports the Appellant’s argument that commands

and/or descriptions that must be built into a query and then translated into commands, as is disclosed by Althoff, is different from a selection formula that is programmed by a user.

The Examiner's assertion that the commands and/or descriptions teaches or suggests a selection formula that is programmed by a user is also inconsistent with the specification of the instant application. For example, FIG. 5 illustrates an exemplary embodiment of a subscription view that includes both a template (options 106, 108, and 110), that would enable commands and/or descriptions to be input by the user, similar to the disclosed user interface in Althoff. The inclusion of the template, separate from a selection formula illustrates that these are construed as separate search criteria input mechanisms within the context of the application.

As was set forth in the Appeal Brief, Peckover also fails to teach or suggest this feature of the claimed invention. *See* the Appeal Brief section (VII)(B)(1). Accordingly, the rejection of claims 1, 6, 11, 13 and 16 is improper and must be overturned because the references, both alone and in combination, fail to teach or suggest all of the features of the claimed invention.

2. *There is no proper motivation to combine Althoff and Peckover.*

The Examiner acknowledges that "Althoff does not clearly teach wherein the search criteria identify information to be searched for and presented to the user at various intervals without additional user intervention, receiving subscription parameter from the user, performing search, and notifying the user." *See* the Office Action at page 3, line 17- page 4, line 2. The Examiner relies on Peckover for these features. The Examiner states that

it would have been obvious to...combine the teachings of Althoff with the teachings of Peckover, wherein the [sic] user interface [of Althoff] receiving the search request from the user for the desired objects to be retrieved from the database from the system provided therein, would incorporate the use of the receiving subscription parameter for searching the magazine subscription, in the same conventional manner as described by Peckover. The motivation being to improve the update system for retrieving, scanning and filtering desired by a user. See *id.* at page 4, lines 10-17 (emphasis added).

The three possible sources for a motivation to combine references include the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-1458 (Fed. Cir. 1998). The Examiner's stated motivation relies on none of these, and is patently improper. In fact, it is not even clear what the Examiner is referring to with the term "the update system." Further, proper motivation for combining the cited references does not exist.

Althoff apparently describes a system and method for enabling a database that is created under an object-oriented protocol to be translated to a relational database, while a model of the object-oriented database is maintained for presentation for a user. See Althoff at col. 3, lines 13-25; and FIG. 2 (elements 220, 230, and 250). The system of Althoff appears to be capable of dynamically translating queries formatted to create, edit, and/or manipulate entries in the object-oriented database into queries for performing the desired actions in the relational database. See *id.* Thus, field of endeavor of Althoff may be characterized as modeling of object-oriented database structures, translation to relational database structures, and dynamic query translation, and the problem to be solved is providing the advantages of object-oriented database management, while retaining the

efficiency of relational database management systems. *See id.* at col. 1, lines 16-18; and col. 2, lines 5-9. At no point does the disclosure of Althoff provide any motivation for combination with Peckover.

Peckover appears to deal with gathering and analyzing market transaction data to assist the activities of market participants within an electronic market. *See* Peckover at col. 1, lines 13-18. Peckover apparently describes a system in which Decision Agents are used to search for ads meeting various criteria, and order the matching ads according to the consumer's preferences. *See id.* at col. 14, lines 45-49. The focus of Peckover appears to include software agents, such as the Decision Agent, to assist the activities of consumers and providers within an electronic "virtual marketplace." Peckover does not provide any suggestion for modifying the system and method for enabling a database that is created under an object-oriented protocol to be translated to a relational database described in Althoff.

Accordingly, the combination of Althoff and Peckover is improper for lacking a proper motivation. For this reason, the rejections of claim 1, 6, 11, and 16 based on the proposed combination are deficient, and must be overturned.

B. CLAIM 33

The rejection of claim 33 under 35 U.S.C §103(a) as allegedly being unpatentable over Althoff in view of Peckover is improper at least for (1) failing to teach or suggest all of the features of the claimed invention, and/or (2) lacking proper motivation to combine the references.

1. *Althoff and Peckover do not teach or suggest all of the features of claim 33.*

Dependent claim 33 recites, among other things syntax checking means for determining whether code input in the programmed selection formula is correct. Peckover does not teach or suggest this feature.

The Examiner admits that Althoff does not teach this feature. *See* the Office Action at page 7, lines 15 and 16. The Examiner relies on Peckover for this feature. *See id.* at page 7, lines 18 and 19. More particularly, the Examiner alleges that Peckover “teaches syntax rules and operation” at col. 6, lines 42-49 [sic]. *See id.* However, as the Examiner correctly points out, this passage of Peckover merely teaches that syntax rules exist. The cited portion of Peckover, and the rest of the disclosure, are silent with respect to syntax checking means, and provide no teaching of any element, or group of elements, that determining whether code input in the programmed selection formula is correct. Therefore, the references do not teach or suggest all of the features of claim 33, and for at least this reason this rejection must be reversed.

2. *There is no proper motivation for combining Althoff and Peckover in the manner proposed.*

Again the Examiner alleges that the combination is proper, with “the motivation being to improve the update system for retrieving, scanning and filtering information desired by the user.” *See* the Office Action at page 8, lines 4 and 5. As has been set forth above in section (VI)(A)(2) of this Brief, this is not a proper motivation for combining references, and no proper motivation for combining the references exists. For at least this reason, the rejection of claim 33 must be reversed.

C. CLAIM 34

The rejection of claim 34 under 35 U.S.C §103(a) as allegedly being unpatentable over Althoff in view of Peckover is improper at least for (1) failing to teach or suggest all

of the features of the claimed invention, and/or (2) lacking proper motivation to combine the references.

1. *Althoff and Peckover do not teach or suggest all of the features of the claimed invention.*

Claim 34 recites, among other things, subscription disabling means for temporarily discontinuing the subscription for a predetermined period of time. The Examiner admits that Althoff does not teach “a predetermined period of time.” See the Office Action at page 7, lines 15 and 16. The Examiner relies on Peckover for this feature. See *id.* at page 7, lines 18 and 19.

More particularly, the Examiner cites Peckover at col. 24, lines 18-32 as teaching “a predetermined period of time.” See *id.* Again, Appellants point out that the Examiner’s assertion is not necessarily material to the patentability of the claim at hand. Further, at col. 24, lines 18-32, Peckover reads as follows:

Continuing to refer to FIG. 8C, a Pending Agents function 160 keeps track of Decision Agents 14 that are performing an extended search. An extended search is a search that remains active for an extended but specific period of time. Results from an extended search may be returned periodically during the time that the search remains active. Pending Agents 160 are [sic] notified by Active Ads 146 when a new advertisement enters the market, and uses an Incremental Search Engine 162 to match each new advertisement against the queries of the pending extended Decision Agents 14. In this way pending Decision Agents 14 are matched against ads, especially limited time special offer ads of providers, that enter the system later than the Decision Agent. Pending Agents 160 also arranges to expire Decision Agents 14 at the end of their expiry time, and to move them to Expired Decision Agent Manager 154.

At best, the cited portion of Peckover appears to teach that an extended search may remain active for a specific period of time. However, this passage provides no teaching of subscription disabling means for temporarily discontinuing the subscription for a

predetermined period of time. Accordingly, the rejection of claim 34 is improper and must be reversed.

2. *There is no proper motivation for combining Althoff and Peckover in the manner proposed.*

Again the Examiner alleges that the combination is proper, with “the motivation being to improve the update system for retrieving, scanning and filtering information desired by the user.” See the Office Action at page 8, lines 4 and 5. As has been set forth above in section (VI)(A)(2) of this Brief, this is not a proper motivation for combining references, and no proper motivation for combining the references exists. For at least this reason, the rejection of claim 34 must be reversed.

D. CLAIM 35

The rejection of claim 35 under 35 U.S.C §103(a) as allegedly being unpatentable over Althoff in view of Peckover is improper at least for (1) failing to teach or suggest all of the features of the claimed invention, and/or (2) lacking proper motivation to combine the references.

1. *Althoff and Peckover do not teach or suggest all of the features of the claimed invention.*

Claim 35 recites, among other things, wherein the search criteria corresponding to the subscription is an electronic mail message containing a predetermined text. The Examiner admits that Althoff does not teach “an electronic mail message containing a predetermined text.” See the Office Action at page 7, lines 15-17. The Examiner relies on Peckover for this feature. See *id.* at page 7, lines 18 and 19.

More particularly, the Examiner asserts that Peckover teaches “e-commerce” at col. 8, lines 10-34. Once again, Applicants point out that even if the Examiner’s assertion with

regard to the disclosure of Peckover were true, Peckover still would not necessarily teach or suggest the claimed feature. In fact, the passage of Peckover relied upon by the Examiner, not included here because of its length, discusses several aspects of e-commerce (or electronic commerce), such as electronic merchandise, and electronic money. However, e-mail (or electronic mail) is not mentioned anywhere in the cited passage, much less an electronic mail message containing a predetermined text. Therefore, Peckover, like Althoff, does not teach or suggest the claimed feature of wherein the search criteria corresponding to the subscription is an electronic mail message containing a predetermined text. For at least this reason, the rejection of claim 35 must be reversed.

2. *There is no proper motivation for combining Althoff and Peckover in the manner proposed.*

Again, the Examiner alleges that the combination is proper, with “the motivation being to improve the update system for retrieving, scanning and filtering information desired by the user.” See the Office Action at page 8, lines 4 and 5. As has been set forth above in section (VI)(A)(2) of this Brief, this is not a proper motivation for combining references, and no proper motivation for combining the references exists. For at least this reason, the rejection of claim 35 must be reversed.

E CLAIM 37

The rejection of claim 37 under 35 U.S.C §103(a) as allegedly being unpatentable over Althoff in view of Peckover is improper at least for (1) failing to teach or suggest all of the features of the claimed invention, and/or (2) lacking proper motivation to combine the references.

1. *Althoff and Peckover do not teach or suggest all of the features of the claimed invention.*

Claim 37 recites, among other things, enabling a user to input a selection formula, said selection formula including search criteria corresponding to a subscription. In an exemplary embodiment, a user may request objects matching a selection formula. A user may input lines of code that identify search criteria. *See* the Specification at page 8, lines 8-10.

In contrast, Althoff expressly teaches that the user interface, relied upon by the Examiner as teaching a selection formula, merely receives commands and descriptions from a user regarding querying or searching a database. *See* Althoff at col. 9, lines 44-47. In response thereto, Althoff discloses, the overall system builds and edits a query model, which may then be translated into a set of SQL commands for querying the database. *See id.* at col. 9, lines 47-55. Therefore, Althoff does not teach or suggest enabling a user to input a selection formula, said selection formula including search criteria corresponding to a subscription. Peckover does not cure this deficiency of Althoff. Accordingly, the rejection of claim 37 is improper and must be reversed.

2. *There is no proper motivation for combining Althoff and Peckover in the manner proposed.*

Again, the Examiner alleges that the combination is proper, with “the motivation being to improve the update system for retrieving, scanning and filtering information desired by the user.” *See* the Office Action at page 9, lines 12 and 13. As has been set forth above in section (VI)(A)(2) of this Brief, this is not a proper motivation for combining references, and no proper motivation for combining the references exists. For at least this reason, the rejection of claim 37 must be reversed.

F. CLAIMS 2, 3, 7, 8, 14, 15, 17, AND 18

The rejection of claims 2, 3, 7, 8, 14, 15, 17, and 18 under 35 U.S.C §103(a) as allegedly being unpatentable over Althoff in view of Peckover and further in view of Conklin is improper at least for (1) failing to teach or suggest all of the features of the claimed invention, and/or (2) lacking proper motivation to combine the references.

Dependent claim 2 recites, among other things, wherein the search performing means performs the search of the at least one database on a random basis. Claims 7, 14, and 17 recite similar features. Claims 3, 8, 15, and 18 depend from, and add to, corresponding ones of claims 2, 7, 14, and 17, and therefore include the features recited in claims 2, 7, 14, and 17. Althoff, Peckover, and Conklin, alone or in combination, fail to teach or suggest this feature.

The Examiner acknowledges that both Althoff and Peckover fail to disclose the search of the at least one database on a random basis. *See* the Office Action at page 10, lines 2 and 3. The Examiner relies on Conklin to disclose this feature.

In particular, the Examiner cites column 29, lines 12-47 of Conklin for support, which has been repeated below, in relevant part, for convenience:

[A]nother principal sponsor function is promoting visibility 213-04. In this capacity, a sponsor 06 may submit its own Website and URL's to a number of Internet search engines and submit each selling participants' Websites and URL's to such search engines as soon as the seller is registered and has created a Website. A typical sponsor's promote visibility functions 213-04 formats the URL's and domain names...into META Tags and Meta Keywords or similar formats and submission schedules most likely to speed up registration with the search engines. For example, the ALTAVISTA™ search engine Web site states that:

The Altavista indexer gives higher priority for keywords located in submit tags (META Tags and Meta Keywords), a higher priority for keywords that

are located near the top of the page, and also gives a tad higher ranking for keywords appearing closer to each other on the page text...
...Since, as noted above, it may take ALTAVISTA™ search engine and others, as many as three months or more to index a site on a purely random basis, submissions such as this can significantly improve the visibility of the new seller Websites from the outset.

The cited portion of Conklin is apparently drawn to a search engine that uses META tags and Meta keywords to index new web sites. Conklin teaches that it may be desirable to submit a new web site to a search engine with formatted META tags and Meta keywords so as to enable the search engine to register the web site more efficiently. The Examiner appears to be relying on the teaching in Conklin that in the absence of META tags and Meta keywords submitted by the new website, the search engine may index the web site on a random basis, which may take much longer than the disclosed method.

Conklin does not teach or suggest search performing means that performs the search of the at least one database on a random basis. The cited portion of Conklin is drawn to a method of indexing websites as an alternative to random indexing, and does not disclose searching databases. In fact, the portion of Conklin relied on by the Examiner does not even relate to searching a database for information matching a subscription. Therefore, Althoff, Peckover, and Conklin, both alone and in combination with one another, fail to teach or suggest search performing means that performs the search of the at least one database on a random basis.

For at least these reasons, the Examiner has failed to establish a *prima facie* case of obviousness based on Althoff in view of Peckover, and in further view of Conklin with regards to claims 2, 3, 7, 8, 14, 15, 17, and 18. Accordingly, the rejection of these claim must be reversed.

G. CLAIMS 4, 9, 12, 19, 22, 23, 25, 26, 28, 29, 31, AND 32

The rejection of claims 4, 9, 12, 19, 22, 23, 25, 26, 28, 29, 31, and 32 under 35 U.S.C §103(a) as allegedly being unpatentable over Althoff in view of Peckover and further in view of Freeman is improper for at least failing to provide a proper suggestion or motivation to combine the references.

Dependent claim 4 recites, among other things, option input means for enabling a user to input one or more options relating to the subscription. Claims 9 and 19 recite similar features. The Examiner relies on Freeman for this feature.

Dependent claim 22 recites, among other things, subscription presenting means for presenting the subscription to the user. Claims 12, 25, 28, and 31 include similar recitations. Claims 23, 26, 29, and 32 depend from claims 22, 25, 28, and 31 respectively.

The Examiner admits that neither Althoff nor Peckover teaches this feature. *See* the Office Action at page 11, lines 19 and 20. The Examiner relies on Freeman for this feature.

The Examiner alleges that the motivation to combine all three of the references, in both of the instances above, would be “to improve the update system for retrieving, scanning and filtering information desired by a user.” *See* the Office Action at page 11, lines 14 and 15, and page 12 at lines 4 and 5. As has been set forth above in section (VI)(A)(2) of this Brief, this is not a proper motivation for combining references, and no proper motivation for combining the Althoff and Peckover references exists.

Freeman apparently discloses delivering facsimile devices, to an electronic mail address as an object file attached to an e-mail message. *See* Freeman at col. 3, lines 32-34.

Freeman provides no motivation for modifying a system for gathering and analyzing market transaction data to assist the activities of market participants within an electronic market, as is taught in Peckover. *See* Peckover at col. 1, lines 13-18. Freeman also does not disclose a system and method for enabling a database that is created under an object-oriented protocol to be translated to a relational database, while a model of the object-oriented database is maintained for presentation for a user, as is disclosed in Althoff, *see* Althoff at col. 3, lines 13-25. Further, neither Althoff nor Peckover disclose the use of facsimile transmissions whatsoever. Therefore, no proper motivation for combining Freeman with Althoff and Peckover exists, and, for at least this reason, the rejection of claims 4, 9, and 19 is improper and must be reversed.

H. CLAIMS 21, 24, 27, AND 30

The rejection of claims 21, 24, 27, and 30 as allegedly being unpatentable over Althoff in view of Peckover and in further view of Freeman is improper for (1) not teaching all of the features of the claimed invention, and/or (2) failing to include proper motivation for combining the references.

1. *Althoff, Peckover, and Freeman fail to teach or suggest all of the features of the claimed invention.*

Dependent claim 21 recites, among other things, wherein the at least one database is a Lotus Notes database. Claims 24, 27, and 30 include similar subject matter.

The Examiner acknowledges that Althoff and Peckover fail to disclose wherein the at least one database is a Lotus Notes database. *See* the Office Action at page 12, lines 12 and 13. The Examiner relies on Freeman to disclose this feature.

In particular, the Examiner cites column 4, lines 36-67 and column 5, lines 1-6 for support, which has been repeated below, in relevant part, for convenience:

An e-mail subscriber also subscribes to a facsimile-delivery-to-electronic-mail system. The subscriber issued a specially designated phone number for receiving facsimile messages via e-mail...

...The e-mail subscriber or facsimile receiver specifies a file format to which a native facsimile object file is to be translated...

...There are also some e-mail client applications, such as Microsoft Exchange and Lotus Notes that are capable of reading and displaying facsimile transmitted graphic images...

...A facsimile server is equipped with various application file translation software programs for translating native facsimile files to subscriber selected formats. A file translation specification is based on a subscriber request, according to the software application that the subscriber uses. For example, if the subscriber uses Microsoft Exchange or Lotus Notes, or other e-mail client applications capable of displaying graphic images, the subscriber will request no translation...

It appears, from the cited passages, that using a Lotus Notes client e-mail application to access e-mail messages may include some advantages within the system described in Freeman. However, the cited portions of Freeman do not include any reference to a Lotus Notes Database. In fact, these passages in Freeman do not reference a database of any kind. Thus, Althoff Peckover and Freeman, both alone and in combination with one another, fail to teach or suggest all of the features of the claimed invention. Therefore, the rejection of claims 21 and 24 is improper and must be reversed.

2. *There is no proper motivation to combine Althoff, Peckover, and Freeman.*

As was discussed in the previous section of this Brief (section (VI)(G)), there is no proper motivation for combining the applied references.

VIII. 37 C.F.R. §41.37(c)(1)(viii) - CLAIMS APPENDIX

Appendix A: The pending claims (claims 1-5, 7-10, 13-16, and 19-22) are attached in Appendix A.

IX. 37 C.F.R. §41.37(c)(1)(ix) - EVIDENCE APPENDIX

Appendix B: (None)

X. 37 C.F.R. §41.37(c)(1)(x) - RELATED PROCEEDINGS INDEX

Appendix C: (None)

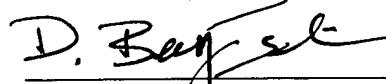
CONCLUSION

For at least the foregoing reasons, Appellant respectfully requests that the rejection of each of pending claims 1-4, 6-11, 13-19, 21-24, and 26-33 under 35 U.S.C. §103(a) be reversed.

Date: March 29, 2006

Respectfully submitted,

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APPENDIX A.

1. **(Previously Presented)** A system for enabling a system user to request a subscription of at least one non-web document from at least one database, comprising:

subscription requesting means for enabling a user to request a subscription of at least one non-web document from at least one database, the subscription requesting means including a selection formula, wherein the selection formula is programmed by the user, the selection formula including search criteria corresponding to the subscription, wherein the search criteria identify information to be searched for and presented to the user at various intervals without additional user intervention;

subscription parameter receiving means for receiving at least one subscription parameter from the user wherein the at least one subscription parameter indicates a type of information to retrieve;

search performing means for performing a search of the at least one database for information matching the subscription;

subscription retrieving means for retrieving the information matching the subscription; and

subscription notification means for notifying the user of matched and retrieved information.

2. **(Previously Presented)** The system of claim 1, wherein the search performing means performs the search of the at least one database on a random basis.

3. **(Previously Presented)** The system of claim 2, wherein the search performing means performs the search on a random basis selected by the user.

4. **(Previously Presented)** The system of claim 1, further comprising option input means for enabling a user to input one or more options relating to the subscription.

5. **(Cancelled).**

6. **(Previously Presented)** A system for enabling a system user to request a subscription of at least one non-web document from at least one database, comprising:

a subscription requesting object that enables a user to request a subscription of at least one non-web document from at least one database, the subscription requesting object including a selection formula, wherein the selection formula is programmed by the user, the selection formula including search criteria corresponding to the subscription, wherein the search criteria identify information to be searched for and presented to the user at various intervals without additional user intervention;

a subscription parameter receiving object that receives at least one subscription parameter from the user, wherein the subscription parameter indicates a type of information to retrieve;

a search performing object that performs a search of the at least one database for information matching the subscription;

a subscription retrieving object that retrieves the information matching the subscription; and

subscription notification means for notifying the user of matched and retrieved information.

7. **(Previously Presented)** The system of claim 6, wherein the search performing

object performs the search of the at least one database on a random basis.

8. **(Previously Presented)** The system of claim 7, wherein the search performing object performs the search on a random basis selected by the user.

9. **(Previously Presented)** The system of claim 6, further comprising an option input object that enables a user to input one or more options relating to the subscription.

10. **(Cancelled).**

11. **(Previously Presented)** A method for enabling a system user to request a subscription of at least one non-web document from at least one database, comprising the steps of:

requesting a subscription for at least one non-web document from at least one database, wherein the request includes a selection formula programmed by a user, the selection formula including search criteria corresponding to the subscription, wherein the search criteria identify information to be searched for and presented to the user at various intervals without additional user intervention;

receiving at least one subscription parameter from the user, wherein the at least one subscription parameter indicates a type of information to be retrieved;

performing a search of the at least one database for information matching the subscription;

retrieving the information matching the subscription; and

notifying the user of matched and retrieved information.

12. **(Previously Presented)** The method of claim 11, further comprising the step of presenting the information to the user.

13. **(Previously Presented)** The method of claim 11, further comprising the step of periodically searching the at least one database.

14. **(Previously Presented)** The method of claim 13, wherein the step of periodically searching the at least one database is performed on a random basis.

15. **(Previously Presented)** The method of claim 14, wherein the step of periodically searching the at least one database is performed on a periodic basis selected by the user.

16. **(Previously Presented)** A processor readable medium having processor readable code embodied therein for enabling a system user to request a subscription of at least one non-web document from at least one database, comprising:

subscription requesting processor readable code for causing a processor to request a subscription of at least one non-web document from at least one database, the subscription requesting processor readable code including a selection formula programmed by a user, the selection formula including search criteria corresponding to the subscription, wherein the search criteria identify information to be searched for and presented to the user at various intervals without additional user intervention;

subscription parameter receiving processor readable code for causing a processor to receive at least one subscription parameter from the user wherein the at least one subscription parameter indicates a type of information to retrieve;

search performing processor readable code for causing a processor to perform a search of the at least one database for information matching the subscription;

information retrieving processor readable code for causing a processor to retrieve the information matching the subscription; and

subscription notifying processor readable code for causing a processor to notify the user of matched and retrieved information.

17. **(Previously Presented)** The medium of claim 16, wherein the search performing processor readable code performs the search of the at least one database on a random basis.

18. **(Previously Presented)** The medium of claim 17, wherein the search performing processor readable code performs the search on a random basis selected by the user.

19. **(Previously Presented)** The medium of claim 16, further comprising option input processor readable code for causing a processor to enable a user to input one or more options relating to the subscription.

20. **(Cancelled).**

21. **(Previously Presented)** The system of claim 1, wherein the at least one database is a Lotus Notes database.

22. **(Previously Presented)** The system of claim 1, further comprising subscription presenting means for presenting the subscription to the user.

23. (Previously Presented) The system of claim 22, wherein the subscription presenting means presents the subscription as an electronic mail message.

24. (Previously Presented) The system of claim 6, wherein the at least one database is a Lotus Notes database.

25. (Previously Presented) The system of claim 6, further comprising subscription presenting means for presenting the subscription to the user.

26. (Previously Presented) The system of claim 25, wherein in the subscription presenting means presents the subscription as an electronic mail message.

27. (Previously Presented) The method of claim 11, wherein the at least one database is a Lotus Notes database.

28. (Previously Presented) The method of claim 11, further comprising the step of presenting the subscription to the user.

29. (Previously Presented) The method of claim 28, wherein the presenting step presents the subscription as an electronic mail message.

30. (Previously Presented) The medium of claim 16, wherein the at least one database is a Lotus Notes database.

31. **(Previously Presented)** The medium of claim 16, further comprising subscription presenting processor readable code for causing a processor to present the subscription to the user.

32. **(Previously Presented)** The medium of claim 31, wherein the subscription presenting processor readable code presents the subscription as an electronic mail message.

33. **(Previously Presented)** The system of claim 1, further comprising syntax checking means for determining whether code input in the programmed selection formula is correct.

34. **(Previously Presented)** The system of claim 1, further comprising subscription disabling means for temporarily discontinuing the subscription for a predetermined period of time.

35. **(Previously Presented)** The system of claim 1, wherein the search criteria corresponding to the subscription is an electronic mail message containing a predetermined text.

36. **(Cancelled).**

37. **(Previously Presented)** A method for enabling a system user to request a subscription of at least one document from at least one database, comprising the steps of:
enabling a user to input a selection formula, said selection formula including search criteria corresponding to a subscription, wherein said search criteria identify information to be

searched for and presented to the user at various intervals without additional user intervention;

performing a search in said at least one database to identify the information corresponding to said search criteria of said selection formula;

retrieving said identified information; and

presenting said retrieved information to the user.

APPENDIX B

NONE

APPENDIX C

NONE